

Application No. 10/602,998  
Amendment dated August 12, 2005  
Reply to Office Action of April 18, 2005

### **REMARKS**

Claim 14 is cancelled. Claims 1-2 are amended. Claims 1-13 and claim 15 are now pending. Reconsideration is respectfully requested in view of the following remarks.

#### **I. Priority**

Applicants have amended the specification to properly claim priority the prior applications as required under 37 CFR 1.78(a)(2) and (a)(5).

#### **II. Claim Objection**

Claim 14 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicants have cancelled claim 14, and as such Applicants respectfully request that the above objection be withdrawn.

#### **III. Claim Rejections Under 35 U.S.C. 102(e):**

Claims 1, 14, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Boles et al. (US 6,300,070).

Under MPEP 2136.05, "a 102(e) rejection can be overcome by antedating the filing date [] of the reference by submitting an affidavit or declaration [] establishing that the relevant disclosure is applicant's own work." Applicants submit herewith two such declarations. The first declaration by Mark Berninger, an inventor of the claimed invention, illustrates conception of the claimed invention prior to the filing date of Boles et al. The second declaration by Albert P. Halluin, the partner that supervised Wallace Wu, the patent attorney who drafted the pending application illustrates Applicants' diligence in reducing the invention into practice (constructive reduction to practice).

As Applicants conceived the claimed invention prior to Boles et al. and diligently reduced it to practice, Boles et al. does not anticipate the presently claimed invention. Therefore, Applicants respectfully request that the Examiner withdrawn the above rejection.

Application No. 10/602,998  
Amendment dated August 12, 2005  
Reply to Office Action of April 18, 2005.

**IV. Claim Rejections Under 35 U.S.C. 103(a):**

Claims 2-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rava et al. (US 6,545,531) and Boles et al. (US 6,300,070).

In order to satisfy the requirements for establishing a *prima facie* case of obviousness, prior art reference(s) must teach or suggest all of the claimed limitations.

Applicants respectfully traverse the Examiners rejection because Boles et al. is not a prior art reference (see above), and Rava et al. neither teaches nor suggests the claimed limitation. In particular, claim 2 requires that a "releasable primer [] or a releasable sequence [be] immobilized on a derivatized area." While the examiner states that "Rava et al. teach cleavable moieties (i.e. part of the nucleic acid) (*Column 3, Lines 39-67*)" (Office Action, page 5), nowhere in Rava et al. is there any mention of releasable primers. Therefore, Rava et al. does not make claim 2 obvious.

Moreover, claim 3 includes the limitation of "a forward primer" and "a reverse primer." However, as stated in the Office Action on page 6, "Rava et al. [] do not teach primers." As such, Rava et al. does not teach or suggest all of the claimed limitations of claim 3. Therefore, Rava et al. does not make claim 3 obvious.

Finally, claims 4-13 all depend on claim 2 or 3 and include all of the limitations of the foregoing claims. As such, Rava et al. does not disclose or suggest all of the claimed limitations of claims 4-13.

For the foregoing reasons, Applicants respectfully request that the Examiner withdraw the above rejection under 35 U.S.C. 103(a) of claims 2-13.

Application No. 10/602,998  
Amendment dated August 12, 2005  
Reply to Office Action of April 18, 2005

**CONCLUSION**

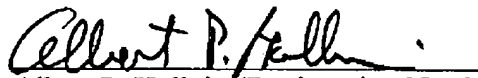
In light of the remarks set forth above, Applicants believe that they are entitled to a letters patent. Applicants respectfully solicit the Examiner to expedite the prosecution of this patent application to issuance. Should the Examiner have any question, the Examiner is encouraged to telephone the undersigned.

Please grant any extensions of time required to enter this response. Also, please charge any required fees due in connection with this submission, and credit any overpayment to Deposit Account No. 23-2415 (Attorney Docket No. 28690-705).

Respectfully submitted,

Date: August 12, 2005

By:

  
Albert P. Halluin (Registration No. 25,227)  
Maya Skubatch (Registration No. 52,505)

Enclosures: Declarations of Albert P. Halluin and Mark Berninger

WILSON SONSINI GOODRICH & ROSATI  
650 Page Mill Road  
Palo Alto, CA 94304-1050  
(650) 849-3330  
Client No. 021971